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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of: Anand Huprikar et al.

Serial No.: 10/619,913

Group Art Unit: 3683

Filed: 07/15/2003

Examiner: Nguyen, Xuan Lan T.

Title: MIXED MODE MOUNTING ASSEMBLY
FOR SHOCK/STRUT ROD

Attorney Docket No.: IN-12163

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Dear Sirs:

In response to the Final Office Action dated 2/13/2006 and also in response to the Interviews with the Examiner conducted on May 22, 2006 and May 24, 2006, Applicant respectfully requests pre-appeal review of the final rejection in the above-identified application. No amendments are being filed with this request. This request is being filed with a Notice of Appeal. The pre-appeal review is requested for the reasons stated immediately below in the Remarks.

REMARKS

Applicant respectfully asserts that a variety of clear errors have been made in the Examiner's final 102 and 103 rejections as set forth in detail in the Official Action of 2/13/2006.

Independent claim 1 of the present application requires, in part;

said first portion of said insulator disposed within said cavity defining **an exterior surface complementary in configuration with said inner surface** of said first cup. . . (emphasis added),

said support structure further including a flange extending outwardly from said first cup with **said flange uniformly positioned relative to said ledge** . . . (emphasis added),

and independent claim 31 requires, in part;

said flange uniformly positioned relative to said ledge. . .

The Examiner has maintained that Pradel (U.S. Patent No. 6,076,794) discloses each and every feature of claim 1 such that claim 1 is anticipated by Pradel. The Examiner has also maintained that claim 31 is unpatentable in light of Pradel.

Applicant has repeatedly argued that Pradel does not disclose an insulator having a surface that is ***complementary in configuration*** with a cup or a flange that is ***uniformly positioned*** relative to a ledge of an insulator (see Applicant's Amendment of October 28, 2005, on page 10, and Applicant's Interview Summary filed concurrently herewith).

As discussed in the October 28th Amendment on page 10, Pradel discloses a cup 4, which is part of the support structure 4, 15, having numerous indentations. One of the indentations is shown next to the leader line of reference numeral 9 in Figure 1 of Pradel. The indentations presumably prevent rotation (see Col. 3, lines 50-64). An insulator 9 is disposed in the cup 4 with the insulator 9 engaging the indentations. The inwardly projecting indentations create a series of gaps between the insulator 9 and the cup 4. One of the gaps is shown next to the arrow head of reference numeral 2 in Figure 1 of Pradel.

As set forth in the Interview Summary filed herewith, the Examiner stated that the repeating pattern of the indentations in Pradel creates a 'uniform' cup. Applicant argued that the term "uniform" is being used in the context of the flange uniformly positioned

relative to the ledge in all instances. Applicant specifically referred the Examiner to Figure 1 of Pradel, which illustrates the flange in one position relative to the ledge on the right side of the assembly and the flange in another completely different position relative to the ledge on the left side of the assembly. The flange is clearly positioned outbound of the ledge on the left side of the assembly over the gap formed between the cup 4 and the insulator 9. Accordingly, the Examiner's interpretation of the "uniform" term, as used in claims 1 and 31, is simply incorrect.

As also set forth in the Interview Summary filed herewith, the Examiner conceded that the insulator in Pradel does NOT have the same configuration as the cup in Pradel. However, the Examiner states that the insulator abuts the cup at each of the indentations such that the insulator is 'complementary' with the cup. Applicant argued that the phrase "complementary in configuration" means that the shape or configuration of the outer surface of the insulator and the inner surface of the cup must be the same. In other words, unlike Pradel, there cannot be any defined gaps between the insulator and the cup. The interpretation of this phrase is supported by the Webster definitions proffered by the Examiner. In accordance with a proper interpretation of this phrase, the insulator 9 of Pradel is NOT complementary in configuration with the cup 4 in Pradel. Therefore, the Examiner's interpretation of the "complementary in configuration" phrase is simply incorrect and the 102 rejection of claim 1 should be withdrawn.

In addition, independent claim 31 further requires, in part;

said insulator abutting said plate. . .

a jounce bumper. . . mounted to said plate on an opposite side from
said insulator. . .

Again, Applicant respectfully submits that the Examiner has failed to establish the requirements for a *prima facie* rejection of claim 31 based on 35 U.S.C. 103.

As argued in the October 28th Amendment on pages 11 and 12, the jounce bumper in Pradel is mounted to plate **21** and the insulator is mounted to a different plate, which is plate **11**. The Examiner's rejection states that the jounce bumper is mounted to plate 11 on the same side of the insulator, which is also mounted to plate 11 (see page 6 of the Official Action of 2/13/06). The Examiner then states it would be obvious to have the

jounce bumper mounted to an opposite side of the plate 11 from the insulator. This rejection was and still is quite confusing because it begins with the premise that the jounce bumper and insulator are mounted to the same plate, e.g., plate 11. This is simply not the case. In order to clarify the rejection, Applicant conducted the interviews of May 22nd and May 24th, 2006.

As set forth in the Interview Summary filed herewith, the Examiner contends that the term “mounted” is broad enough to cover the situation where the jounce bumper is indirectly mounted to the plate. Hence, the Examiner believes it would be obvious to reconfigure Pradel to arrive at the configuration of the subject invention as claimed in claim 31.

As preemptively argued in the October 28th Amendment on pages 11 and 12, and as discussed in the Interview Summary filed herewith, Applicant contends that this obviousness rejection is improper because it would require a complete reconstruction of Pradel to arrive at the invention as claimed in claim 31. The Examiner fails to appreciate the fact that the jounce bumper and insulator of the subject invention as claimed are mounted to the same plate and that Pradel simply does not disclose, teach, or suggest this structure.

The Examiner contends in the Official Action of 2/13/06 that it would have been obvious “to have arranged the plate, the insulator and the jounce bumper as claimed, since it has been held that rearranging parts of an invention involves only routine skill in the art”. The Examiner did not specifically state what is meant by “rearranging parts” and, during the interviews, Applicant was unable to clarify how Pradel would be modified. In any event, Applicant respectfully disagrees with this contention. In order to sustain a rejection of claim 31 using Pradel, the Examiner would need to completely and improperly redesign the assembly of Pradel using only hindsight as the Examiner’s guide. In particular, at least the cup 4, insulator 9, plate 11, cup 15, insulator 8, and plate 21 in Pradel would need to be modified, repositioned, and/or reconfigured to arrive at a configuration that even remotely resembles the configuration of the subject invention as claimed in claim 31. As is well settled, a whole sale restructuring of the prior art to find a

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claimed invention is not proper. Accordingly, the 103 rejection of claim 31 is believed improper and should also be withdrawn.

Due to the Examiner's mistakes and omissions, the requirements for sustaining a rejection based on either 35 U.S.C. 102 or 103 have **not** been satisfied. Accordingly, these rejections should be withdrawn.

Based on the above summary and the correspondence of record, Applicants believe that the claims in the present application are in condition for allowance. Further, Applicants respectfully request review of the Examiner's position relative to the "complementary" and "uniform" terms as used in claims 1 and 31, as well as the obviousness rejection as applied to claim 31, prior to Applicant's filing a formal Appeal Brief.

The Commissioner is authorized to charge the Deposit Account No. 08-2789, in the name of Howard & Howard Attorneys, P.C., for any fees or credit the account for any overpayment.

The undersigned is an attorney acting under 37 CFR 1.34.

Respectfully submitted,

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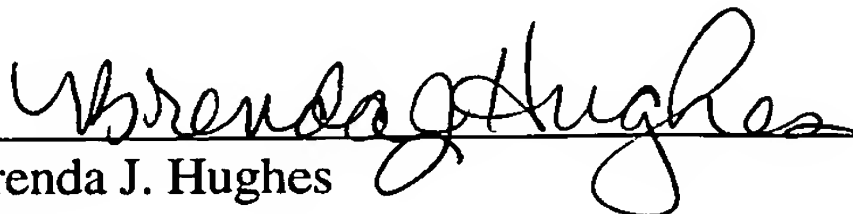
Dated: June 7, 2006



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CERTIFICATE OF EXPRESS MAIL

I hereby certify that the attached **Pre-Appeal Brief Request For Review, Interview Summary, and return post card** are being deposited with the United States Postal Service as Express Mail, Express Mail Label No. EV 695 477 837 US, postage prepaid, in an envelope addressed to **Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, Virginia 22313-1450**, on **June 7, 2006**.


Brenda J. Hughes

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